

III. REMARKS

Claims 1-26 are pending in this application. By this amendment, claims 1, 8, 15 and 21 have been amended. Applicant is not conceding in this application that those claims are not patentable over the art cited by the Office, as the present claim amendments and cancellations are only for facilitating expeditious prosecution of the subject matter. Applicant does not acquiesce in the correctness of the rejections and reserves the right to present specific arguments regarding any rejected claims not specifically addressed. Further, Applicant reserves the right to pursue the full scope of the subject matter of the original claims in a subsequent patent application that claims priority to the instant application. Reconsideration in view of the following remarks is respectfully requested.

In the Office Action, claims 1-26 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Stern (U.S. Patent Pub. No. 2002/0032740), hereafter "Stern."

REJECTION OF CLAIMS 1-26 UNDER 35 U.S.C. §103(a)

With regard to the 35 U.S.C. §103(a) rejection over Stern, Applicant asserts that Stern does not teach or suggest each and every feature of the claimed invention. For example, with respect to independent claims 1 and 21 and similarly claimed in claims 8 and 15, Applicant submits that Stern fails to teach or suggest that the valid electronic address is determined by iterating through the sequence of address generation scripts in order of which address generation script is preferred by an organization to which the user belongs. Stern has no provision for this kind of ordering and could not, because the passage of Stern cited by the Office is only performed "...[i]n the event that there is no person's email address from which to reverse

engineer the company standard email address format and interpolate (generate) email addresses for others at the given company/organization.” Para. 0163.

In contrast, the claimed invention includes “...determining a valid electronic address for assigning to a user by iterating through the sequence of address generation scripts in order of which address generation script is preferred by an organization to which the user belongs” Claim 1. As such, in contrast to Stern, the iterating of claimed invention is in order of which address generation script is preferred by an organization to which the user belongs. Thus, Stern does not teach iteration of the claimed invention. Accordingly, Applicant respectfully requests that the Office withdraw its rejection.

With further respect to independent claims 1, 8, 15 and 21, Applicant respectfully submits that Stern also fails to teach or suggest that the valid electronic address is determined without consuming email reception resources of the organization. In contrast, the passages of Stern cited by the Office requires verification of the email address by sending text emails to the interpolated/generated email addresses, thereby consuming email reception resources of the organization. Accordingly, Applicant respectfully requests that the Office withdraw the rejection.

With still further respect to independent claims 1, 8, 15 and 21, Applicant continues to respectfully submit that Stern also fails to teach or suggest one of the address generation scripts produces a previously unused electronic address. In contrast, the passages of Stern cited by the Office indicate that a goal of Stern is to decipher valid email address. To this extent, Stern does not teach or suggest producing a previously unused electronic address. The Office indicates that it would be obvious to integrate a feature such as this into the Stern reference to yield the claimed

invention. Applicant asserts that the Office's factual assertion amounts to Official Notice and is not properly based upon common knowledge. For example, Applicant asserts that automatic generation of previously unused email addresses from scripts is not obvious to one skilled in the art as asserted by the Office. Furthermore, the generation of previously unused email addresses is inconsistent with Stern, which seeks to find email addresses that are currently in use. Accordingly, Applicant respectfully requests that the Office support the finding with references that show these features or withdraw the rejection.

With respect to dependent claim 3, Applicant continue to respectfully submit that Stern also fails to teach or suggest that one of the address generation scripts that produces the previously unused electronic address using user data is provided from a repository and wherein the sequence of address generation scripts are generated by a user. In contrast, Stern, which indicating that the name of the person for which the email is to be determined is in its database, does not teach or suggest that the combinations that the Office equates with the address generation scripts of the claimed invention are stored in the database. Accordingly, Applicant respectfully requests that the rejection be withdrawn.

With respect to dependent claim 5, Applicant respectfully submit that Stern also fails to teach or suggest comparing the first electronic address to a set of previously created electronic addressed to determine if the first address is unique. In support of its argument to the contrary, the Office cites a passage of Stern, which describes an integrator for resolving duplicate information. However, this component of Stern is described separately from the post processor that it uses to generate missing information such as email addresses. Furthermore, the post processor would not even be invoked by Stern in the case of an email address existing for a

particular person because the email address would not be classified as missing. As such, the integrator and post processor of Stern would not work in the way that the Office constructs in its argument. Still further, Stern does not teach or suggest making a determination as to whether the generated email address belongs to a person other than the one for which the system is making the determination. Accordingly, Applicant respectfully requests that the rejection be withdrawn.

With respect to the Office's other arguments regarding dependent claims, Applicant herein incorporates the arguments presented above with respect to the independent claims from which the claims depend. Furthermore, Applicant submits that all dependant claims are allowable based on their own distinct features. Since the cited art does not teach each and every feature of the claimed invention, Applicant respectfully requests withdrawal of this rejection.

IV. CONCLUSION

In addition to the above arguments, Applicant submits that each of the pending claims is patentable for one or more additional unique features. To this extent, Applicant does not acquiesce to the Office's interpretation of the claimed subject matter or the references used in rejecting the claimed subject matter. Additionally, Applicant does not acquiesce to the Office's combinations and modifications of the various references or the motives cited for such combinations and modifications. These features and the appropriateness of the Office's combinations and modifications have not been separately addressed herein for brevity. However, Applicant reserves the right to present such arguments in a later response should one be necessary.

In light of the above, Applicant respectfully submits that all claims are in condition for allowance. Should the Examiner require anything further to place the application in better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the number listed below.

Respectfully submitted,



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